

Exhibit 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

William Archie McDow, Jr., et al.

Serial No.: 14/856,534

Filed: August 11, 2017

For: Pipe Flashing Apparatus and
Method

Examiner: Sara S. Clarke

Group Art Unit: 3993

Confirmation No.: 6318

March 19, 2019

RESPONSE TO OFFICE ACTION

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

This paper is being filed in response to the non-final Office Action dated December 19, 2018. The three-month shortened statutory period for reply expired on March 19, 2019. Accordingly, this amendment is timely filed. Fees for all necessary extensions, the Petition for Revival, and any other required fees, may be charged to Deposit Account No. 19-2814. Accordingly, this amendment is timely filed. Please amend the above-identified application as follows.

Amendments to the Claims are reflected in the listing of claims that begins on page 2 of this paper.

Remarks/Arguments begin on page 8 of this paper.

Electronic Acknowledgement Receipt

EFS ID:	35471690
Application Number:	14856534
International Application Number:	
Confirmation Number:	6318
Title of Invention:	PIPE FLASHING APPARATUS AND METHOD
First Named Inventor/Applicant Name:	William Archie McDow
Customer Number:	20322
Filer:	Carey M. Rozier/Sharon Nance
Filer Authorized By:	Carey M. Rozier
Attorney Docket Number:	77700.00155
Receipt Date:	19-MAR-2019
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		Response.pdf	137319	yes	11
			0b8e9fda8189dabb11e74ddc0663731f40b9d1a00		

Multipart Description/PDF files in .zip description			
Document Description		Start	End
Applicant Arguments/Remarks Made in an Amendment		8	11
Claims		2	7
Amendment/Req. Reconsideration-After Non-Final Reject		1	1

Warnings:**Information:****Total Files Size (in bytes):**

137319

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

REMARKS

Applicants appreciate the Examiner's careful review of the application. Applicants submit these amendments and remarks in support of patentability. Claims 1, 10, 11, 16, and 17 are amended herein. Claims 9 and 19 are cancelled herein.

DESCRIPTION OF AMENDMENTS AND SPECIFICATION SUPPORT

Markings in the Listing of Claims above show deletions, insertions, and additions in comparison to the claims of patent U.S. 8,534,002 B2 (the '002 patent"). *See* 37 CFR 1.173; MPEP 1453. Differences between the Claims in the above Listing of Claims and the Claims in the Listing of Claims in the previous proposed Amendment of August 7, 2018, as well as exemplary specification support for any added claim language, are as follows.

In claim 1, the phrase “wherein the front portion of the foot includes a reinforcement material, wherein the foot is substantially rectangular, and wherein the back portion of the foot is configured to rest underneath a first shingle and the front portion of the foot is configured to rest on a top of a second shingle” has been added. Support for this addition can be found at least at col. 2, ll. 41-63 and FIGS. 1 and 6.

In claim 1, the phrase “wherein the longitudinal opening is defined by a first edge member having a first flap extending away from the longitudinal opening, and a second edge member having a second flap extending away from the longitudinal opening, wherein the first edge member and the second edge member extend upwardly from the foot, wherein the first edge member includes a first clip groove and the second edge member includes a second clip groove, wherein the first clip groove and the second clip groove are configured to receive a clip to securely fasten the longitudinal opening, wherein the first clip groove forms a right angle with the first flap, and wherein the second clip groove forms a right angle with the second flap” has been added. Support for this addition can be found at least at col. 3, ll. 24-39 and FIG. 2.

In claim 1, the phrase “the longitudinal opening has first and second edges such that” has been deleted.

In claim 1, the phrase “when the first and second edges” has been changed to “when the first and second edge members” to conform to other claim amendments.

Cancellation of claim 9 is requested.

In claim 10, the phrase “foot includes an embedded” has been deleted, and the phrase “comprises a sheet of metal” has been added. Support can be found at least at col. 2, ll. 55-57.

In claim 11, the phrase “embedded reinforcement material” has been deleted, and the word “is” has been added such that the claim reads, in part “a sheet of metal is molded.”

In claim 16, the phrases “wherein the first edge of the longitudinal opening includes a rectangular cross-section and a clip groove formed, in part, by a portion of a top surface of the foot, and” and “a clip groove and a flap, the flap” have been deleted. The word “member” has been added after both “wherein the second edge” and “over a top of the first edge” to conform with amendments to claim 1.

In claim 17, the phrases “of the first edge of the longitudinal opening” and “of the second edge of the longitudinal opening” have been deleted. The clip grooves recited in claim 17 have been renamed the “first clip groove” and “second clip groove to conform with amendments to claim 1.

Cancellation of claim 19 is requested.

Thus, claims 1-4, 6-8, 10-18, and 20-25 are pending, with claim 1 being the only independent claim.

CLAIM REJECTIONS

Claims 1-4, 6, 12, 14, 15, and 20-25 are rejected under pre-AIA 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,588,267 to Rodriguez (“Rodriguez”) in view of U.S. Patent No. 5,176,408 to Pedersen (“Pedersen”). Claims 7-9, 13, 18, and 19 are rejected under pre-AIA 35 U.S.C. 103(a) as being obvious over Rodriguez in view of Pedersen, and further in view of U.S. Patent No. 5,036,636 to Hasty (“Hasty”). Claims 10 and 11 are rejected under pre-AIA 35 U.S.C. 103(a) as being obvious over Rodriguez in view of Pedersen, and further in view of U.S. Patent No. 5,414,964 to Bodycomb (“Bodycomb”). Applicants respectfully traverse these rejections.

The Office Action asserts that the combination of Rodriguez and Pedersen teaches or suggests the limitations of independent claim 1. Although Applicants disagree with that assertion, claim 1 has been amended herein to advance prosecution. Specifically, claim 1 is amended herein to recite, among other features:

wherein the longitudinal opening is defined by a first edge member having a first flap extending away from the longitudinal opening, and a second edge member having a second flap extending away from the longitudinal opening, wherein the first edge member and the second edge member extend upwardly from the foot, wherein the first edge member includes a first clip groove and the second edge member includes a second clip groove, wherein the first clip groove and the second clip groove are configured to receive a clip to securely fasten the longitudinal opening, wherein the first clip groove forms a right angle with the first flap, and wherein the second clip groove forms a right angle with the second flap

Neither Rodriguez nor Pedersen, taken alone or in combination, disclose such features. As the Office Action acknowledges, Rodriguez does not disclose a longitudinal opening of any type. Office Action at p. 2. The Office Action states that Pedersen discloses a longitudinal opening (the slit in rig 25). *Id.* But, as best seen in FIG. 6, the longitudinal opening of Pedersen does not disclose a first clip groove and a second clip groove, and does not disclose a first clip groove that forms a right angle with a first flap and a second clip groove that forms a right angle with a second flap, as recited in amended claim 1. Therefore, the combination of Rodriguez and Pedersen does not render claim 1 obvious. Neither Hasty nor Bodycomb remedy the deficiencies in the combination of Rodriguez and Pedersen, at least because neither Hasty nor Bodycomb teaches or suggests a longitudinal opening as recited in claim 1.

Claims 9 and 19 are cancelled herein. Claims 2-4, 6-8, 10-18, and 20-25 depend from and add limitations to claim 1, and are therefore patentable for at least the same reasons.

CONCLUSION

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns that might prevent timely allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

No additional fees are believed to be due. However, the Commissioner is authorized to charge any fees, or credit any overpayment, in connection with filing this response to Deposit Account No. 19-2814. If a fee is required for an extension of time under 37 C.F.R. § 1.136 or for

any other reason that is not accounted for in the enclosed transmittal, such an extension is requested and the fee should also be charged to the previously stated Deposit Account.

Dated: March 19, 2019

Sincerely,

SNELL & WILMER L.L.P.

/C. Matthew Rozier/

Carey Matthew Rozier

Registration No. 63,429

One Arizona Center

400 East Van Buren

Phoenix, Arizona 85004-2202

Telephone: 602.382.6000

Fax: 602.382.6070

AMENDMENTS TO THE CLAIMS

This Listing of Claims will replace art prior versions, and listings, of claims in the application:

1. (Four Times Amended) A roof flashing comprising:

a collar[, the collar having a conical shape with an apex and a bottom edge] having a collar top and a collar bottom;

a [substantially cylindrical] base[, the base having a top edge and a bottom edge, the top edge of the base coupled to the bottom edge of the collar, the bottom edge of the base having a diameter larger than a diameter of the top edge of the base] having a base top edge and a base bottom edge, the base having a first side with a length longer than a length of a second side opposite the first side, with the lengths measured from the base top edge to the base bottom edge, wherein the base top edge is coupled to the collar bottom and the base extends downwardly from the collar bottom to the base bottom edge;

a foot coupled to the base bottom edge [of the base] and extending outwardly from the base bottom edge [of the base] to a foot edge, said foot extending outwardly at an angle with a front portion of the foot extending downwardly from the base and a back portion of the foot extending upwardly from the base, wherein the front portion of the foot includes a reinforcement material, wherein the foot is substantially rectangular, and wherein the back portion of the foot is configured to rest underneath a first shingle and the front portion of the foot is configured to rest on a top of a second shingle; and

a longitudinal opening extending from the [apex of the] collar top to [an edge of] the foot edge [via the base], wherein the longitudinal opening is defined by a first edge member having a first flap extending away from the longitudinal opening, and a second edge member

having a second flap extending away from the longitudinal opening, wherein the first edge member and the second edge member extend upwardly from the foot, wherein the first edge member includes a first clip groove and the second edge member includes a second clip groove, wherein the first clip groove and the second clip groove are configured to receive a clip to securely fasten the longitudinal opening, wherein the first clip groove forms a right angle with the first flap, and wherein the second clip groove forms a right angle with the second flap,

wherein the longitudinal opening includes first, second, and third sections,

wherein the first section of the longitudinal opening traverses a portion of the collar from [the apex to the bottom edge of the collar, the first section disposed at a first angle] the collar top to the collar bottom at a point where a collar bottom is coupled to the base top edge,

wherein the second section of the longitudinal opening traverses a portion of the base from the collar bottom [top edge of the base] to [the bottom edge of] the base bottom edge, the second section disposed at a second angle that is different than the first angle,

wherein the third section of the longitudinal opening traverses a portion of the foot from [the bottom edge of] the base bottom edge to [the edge of] the foot edge, the third section disposed at a third angle that is different than the first and second angles,

wherein, [the longitudinal opening has first and second edges, and

wherein a width of the longitudinal opening increases when the first and second edges are pulled away from each other to enable the roof flashing to be installable around a pipe which is not capable of receiving the roof flashing over a top thereof] when the first and second edge members are pulled away from each other a width of the longitudinal opening increases to enable the roof flashing to be installable around a pipe which is not capable of

receiving the roof flashing over a top thereof.

2. The roof flashing of claim 1 wherein at least one of the collar, the base, and the foot is made of an elastomeric material.

3. The roof flashing of claim 1 wherein the collar includes a plurality of pipe attachment edges.

4. (Amended) The roof flashing of claim 3 wherein the plurality of pipe attachment edges includes increasing diameters, the pipe attachment edge nearest [the apex of] the collar top having the smallest diameter, and the pipe attachment edge nearest [the bottom edge of] the collar bottom having the largest diameter.

5. (Previously Cancelled)

6. (Amended) The roof flashing of claim 3 wherein a second portion of the collar is capable of being removed by tearing and/or cutting the second portion of the collar along a tear groove corresponding to at least one of the plurality of attachment edges.

7. The roof flashing of claim 1 being capable of integrating with shingles on a roof when installed on the roof.

8. The roof flashing of claim 7 being capable of layering with the shingles on the roof when installed on the roof.

Please cancel claim 9.

10. (Amended) The roof flashing of claim 1 wherein the [foot includes an embedded] reinforcement material comprises a sheet of metal.

11. (Amended) The roof flashing of claim 10 wherein the [embedded reinforcement material includes a] sheet of metal is molded within an elastomeric material forming the foot.

12. The roof flashing of claim 1 wherein the foot and the base are capable of being coupled together at a plurality of different angles.

13. The roof flashing of claim 1 wherein, when installed on a roof, the foot functions as a shingle on the roof

14. The roof flashing of claim 1 wherein, when brought together, the first and second edges of the longitudinal opening form a longitudinal seal.

15. (Amended) The roof flashing of claim 14 further comprising at least one

fastener for securing the longitudinal seal.

16. (Amended) The roof flashing of claim 1 [wherein the first edge of the longitudinal opening includes a rectangular cross-section and a clip groove formed, in part, by a portion of a top surface of the foot, and] wherein the second edge member of the longitudinal opening includes a rounded top[, a clip groove and a flap, the flap] sized to fit against and over a top of the first edge member of the longitudinal opening.

17. (Amended) The roof flashing of claim 16 where the first clip groove [of the first edge of the longitudinal opening] and the second clip groove [of the second edge of the longitudinal opening] are capable of receiving respective edges of at least one fastener.

18. (Amended) The roof flashing of claim 1 wherein the [substantially cylindrical] base is substantially cylindrical and tapers from the bottom edge of the base to the top edge of the base.

Please cancel claim 19.

20. The roof flashing of claim 1 wherein the foot is integral with the base.

21. The roof flashing of claim 1, wherein the flashing is fabricated in a single

molding operation.

22. (New) The roof flashing of claim 1 wherein the collar has a conical shape and wherein the collar top is an apex of the conical shape.

23. (New) The roof flashing of claim 1 wherein the collar includes an annular groove situated between the collar top and the collar bottom, the annular groove corresponding to a pipe diameter, and wherein an attachment edge can be formed by removing the portion of the collar between the collar top and the annular groove.

24. (New) The roof flashing of claim 23 having a plurality of annular grooves wherein each of said plurality of annular groove corresponds to a respective pipe diameter and wherein the attachment edge can be formed by removing a portion of the collar between the collar top and one of said plurality of annular grooves.

25. (New) The roof flashing of claim 24 wherein the plurality of annular grooves have increasing diameters, the annular groove nearest the collar top having a smallest diameter, and the annular groove nearest the collar bottom edge having a largest diameter.

Previously submitted new claim 26 is cancelled.

Previously submitted new claim 27 is cancelled.

PATENT APPLICATION FEE DETERMINATION RECORD Substitute for Form PTO-875				Application or Docket Number 14/856,534		Filing Date 09/16/2015		<input type="checkbox"/> To be Mailed			
ENTITY: <input type="checkbox"/> LARGE <input checked="" type="checkbox"/> SMALL <input type="checkbox"/> MICRO											
APPLICATION AS FILED - PART I											
		(Column 1)		(Column 2)							
FOR		NUMBER FILED		NUMBER EXTRA		RATE (\$)		FEE (\$)			
<input type="checkbox"/> BASIC FEE (37 CFR 1.16(a), (b), or (c))		N/A		N/A		N/A					
<input type="checkbox"/> SEARCH FEE (37 CFR 1.16(k), (l), or (m))		N/A		N/A		N/A					
<input type="checkbox"/> EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))		N/A		N/A		N/A					
TOTAL CLAIMS (37 CFR 1.16(i))		minus 20 = *				x \$40 =					
INDEPENDENT CLAIMS (37 CFR 1.16(h))		minus 3 = *				x \$210 =					
<input type="checkbox"/> APPLICATION SIZE FEE (37 CFR 1.16(s))		If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$310 (\$155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).									
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))											
* If the difference in column 1 is less than zero, enter "0" in column 2.						TOTAL					
APPLICATION AS AMENDED - PART II											
		(Column 1)		(Column 2)		(Column 3)					
AMENDMENT	03/19/2019	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR		PRESENT EXTRA		RATE (\$)		ADDITIONAL FEE (\$)	
	Total (37 CFR 1.16(i))	* 22	Minus	** 25	= 0		x \$50 =		0		
	Independent (37 CFR 1.16(h))	* 1	Minus	*** 3	= 0		x \$230 =		0		
	<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))										
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))										
								TOTAL ADD'L FEE		0	
		(Column 1)		(Column 2)		(Column 3)					
AMENDMENT		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR		PRESENT EXTRA		RATE (\$)		ADDITIONAL FEE (\$)	
	Total (37 CFR 1.16(i))	*	Minus	**	=		x \$0 =				
	Independent (37 CFR 1.16(h))	*	Minus	***	=		x \$0 =				
	<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))										
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))										
								TOTAL ADD'L FEE			
* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.								LIE			
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".								/TYWANA P LOVELACE/			
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".											
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.											

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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